

## REMARKS

Claims 1- 41 are pending in the present application. New claims 42-50 have been added. Claims 1, 3, 11, 12, 16, and 28 have been amended. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

New claim 42 refers to commands executed within the SIM that are related to a card holder verification (CHV) feature. Claims 43-50 refer to GSM application file level data that can be stored in the SIM.

### **Rejections Under 35 U.S.C. 112, second paragraph**

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states in the office action dated April 24, 2003:

Claims 1, 16, and 28 recite "... a GSM core infrastructure..." It is unclear what is meant by a 'core infrastructure'. It is noted that item 14 in figure 1 shows a 'GSM core' however, it is unclear what element or elements are present in item 14 that make up a 'GSM core infrastructure'.

Applicants respectfully traverse the 35 U.S.C. 112, second paragraph rejection. The concept of a "GCM core infrastructure" is not unclear and is supported by the specification. The GSM core infrastructure is a wireless system. See paragraph 5. It is a GSM core network. See paragraph 2. The GSM core infrastructure 14 communicates with the wireless radio access network (RAN) 12 through a CDMA/GSM Mobile Switching Center (MSC) 28. See paragraph 27. In addition, the GSM core infrastructure 14 can communicate with a public switched telephone network (PSTN) and/or a data network 16, such as the Internet. See paragraph 17.

35 U.S.C. 112, second paragraph states that the “claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The internal elements of a GSM core infrastructure other than the described GSM Home Location Register (HLR) 26 and GSM authentication center (AUC) 27 are not relevant. What is relevant is the ability to interface to the GSM system 14. Thus, the claims meet the requirements of 35 U.S.C. 112, second paragraph and the 35 U.S.C. 112, second paragraph rejection is overcome.

#### **Rejections Under 35 U.S.C. 102**

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (USPN 5,537,474), hereafter referred to as Brown. Claims 16-18 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahn et al. (Publication number 2002/0061745), hereafter referred to as Ahn.

Independent claims 1, 16, and 28 recite a SIM that stores GSM application file level data and telecom level data, and executes commands. Neither Brown, nor Ahn discloses a SIM that stores GSM application file level data and telecom level data, and executes commands as required by independent claims 1, 16, and 28. Thus, the 35 U.S.C. 102 rejections are overcome and independent claims 1, 16, and 28 are patentable.

#### **Rejections Under 35 U.S.C. 103**

The examiner cites 103(a) as the basis for all obviousness rejections set forth in this Office action:

Claims 6-8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Thomas (USPN 6,014,558)

Claim 9, is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Tiedemann (USPN 5,862,471)

Claim 10, is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Skog (USPN 5,930,701)

Claim 11, is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Maruyama (USPN 5,646,604)

Claims 12-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Cassidy (USPN 6,480,725)

Claim 15, is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

Claims 19, 20, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Thomas

Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Tiedeman.

Claims 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Skog.

Claims 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Maruyama.

Claims 24-26 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn in view of Cassidy.

Claims 27 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn.

Dependent claims 2-15 are dependent on patentable independent claim 1 and are therefore patentable. Dependent claims 17-27 are dependent on patentable independent claim 16 and are therefore patentable. Dependent claims 29-41 are dependent on patentable independent claim 28 and are therefore patentable.

### CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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